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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,921	07/10/2000	John E. Sims	03260.0047	9162

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EXAMINER

CHERNYSHEV, OLGA N

ART UNIT	PAPER NUMBER
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1649

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/612,921

Applicant(s)

SIMS, JOHN E.

Examiner

Olga N. Chernyshev

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 58-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 58 is/are allowed.
- 6) ☒ Claim(s) 59-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1. The Board of Patent Appeals and Interferences reversed the rejection(s) under 35 U.S. §§ 101, 112, first paragraph against claims 58-67 in the decision of November 30, 2005.
2. In view of the newly discovered reference(s), PROSECUTION IS HEREBY REOPENED. Rejections based on the newly cited reference(s) follow.

### ***Priority***

3. It is noted that the instant claimed nucleic acid molecules of SEQ ID NO: 3 were first disclosed in the provisional application 60/087,393, filed 06/01/1998, which establishes the priority date of the instant invention.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. • Claims 59-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Eaton et al, US 2002/0119130 A1, published August 29, 2002, filing date of October 29, 1997.

Claims 59-67 are directed to an isolated nucleic acid molecules comprising the nucleic acid sequence of SEQ ID NO: 3. Eaton et al. document discloses a nucleic acid sequence of SEQ ID NO: 151, which is 100% identical to the instant claimed nucleic acid sequence of SEQ ID

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NO: 3 (see a copy of the sequence alignment attached to the instant office action). Thus, Eaton et al. disclosure fully anticipates the instant invention.

6. Claims 59-67 are further rejected under 35 U.S.C. 102(e) as being anticipated by Ford et al., US Patent 6,337,072, filing date of 05/20/1998.

Claims 59-67 are directed to an isolated nucleic acid molecules comprising the nucleic acid sequence of SEQ ID NO: 3. Ford et al. document discloses a nucleic acid sequence of SEQ ID NO: 4, which is 100% identical to the instant claimed nucleic acid sequence of SEQ ID NO: 3 (see a copy of the sequence alignment attached to the instant office action). Thus, Ford et al. document fully anticipates the instant invention.

7. Claims 60-62 are rejected under 35 U.S.C. 102(e) as being anticipated by Ford et al., US Patent 6,541,623, filing date of 05/20/1998.

Claims 60-62 are directed to fragments of nucleic acid molecule of SEQ ID NO: 3. Ford et al. document discloses probes, which are fragments of SEQ ID NO: 4, which is 100% identical to the instant nucleic acid sequence of SEQ ID NO: 3 (see a copy of the sequence alignment attached to the instant office action). Thus, Ford et al. fully anticipates the instant invention.

### ***Conclusion***

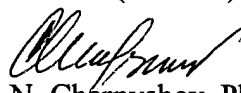
8. Claim 58 is free of prior art and has utility as a marker of chromosome 2, region q11.2-q14.2. Claim 58 is allowed. Claims 59-67 are rejected.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (571) 272-0870. The examiner can normally be reached on 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Olga N. Chernyshev, Ph.D.  
Primary Examiner  
Art Unit 1649

February 14, 2006



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JANET L. ANDRES  
SUPERVISORY PATENT EXAMINER